

REMARKS

This Response is submitted in response to the Office Action dated April 7, 2003. A Request for Continued Examination ("RCE") is submitted herewith. Claims 1, 3, 4, 6 to 10, 12, 13 and 15 to 38 are pending. Claims 1, 3, 4, 9, 10, 12, 13, 15, 16, 17 to 33, and 38 have been amended. No new matter has been added through any of these amendments. Claims 2, 5, 11 and 14 have been canceled without prejudice or disclaimer.

A Petition for a one-month extension of time to respond to the Office Action is submitted herewith. Checks in the amount of \$590.00 and \$750.00 are submitted herewith to cover the cost of the two month extension, the RCE and the Supplemental Information Disclosure Statement. Please charge Deposit Account No. 02-1818 for any in sufficiency or credit for any overpayment.

The Office Action rejected Claims 1 to 14, and 38 under 35 U.S.C. § 103(a) as being unpatentable over Yoseloff (U.S. Patent No. 6,312,334) in view of Koza (U.S. Patent No. 4,582,324). The Office Action states that Yoseloff does not teach the following element of the present invention:

The initial award being selected from a first pool; the second award being from a second pool and the third award being from a third pool wherein the first, second and third pools are used repeatedly so that repeated play of the game provides information about the ranges of values in the pools.

The Office Action cites to Koza as describing a multi-level pool system wherein predetermined game outcomes are selected from different award pools to ensure appropriate distribution of the possible outcomes from each level. The Office Action concludes that it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the gaming device taught by Yoseloff, wherein the player is offered awards selected from a plurality of pools.

Yoseloff discloses a game such as Let's Make a Deal® wherein the prize win is dependent on the selection of the player or the player input signals. Yoseloff discloses a display of three doors. The player selects from among the three doors, and the selection may include: one door causing loss of the entire wager, a second door causing a more neutral event, and a third door causing a doubling or otherwise

substantial increase in the wager award. Thus, the prize win in Yoseloff is dependent on the selection by the player. As the Office Action itself notes, Koza teaches "means for providing an opportunity to win a prize in response to activation by the player and for determining a prize win independent of player input signals." (emphasis added). Koza teaches away from Yoseloff, because Yoseloff discloses a prize win being dependent on a player selection. The Office Action cannot properly combine Yoseloff and Koza without reading each reference as a whole. The Office Action may not pick out individual elements from these references to conclude that the present invention is obvious. Such a parsing out of elements is improper because it involves the use of improper hindsight. Obviousness cannot be based on the hindsight combination of components selectively culled from prior art to fit the parameters of the claimed invention. *ATD Corp. v. Lydall*, 48 U.S.P.Q.2d 1321, 1329 (Fed. Cir. 1998); MPEP § 2142. However, even with the use of improper hindsight, the combination of Yoseloff and Koza do not disclose, teach or suggest the present invention as claimed in amended independent Claims 1, 10 and 38.

The present invention includes a prize win or an award won by the player that is dependent on a player selection. As explained above, Koza teaches away from this element of the present invention.

Additionally, the Office Action states that Yoseloff discloses a gaming system that entices players to risk an initial award in return for the opportunity to receive greater payoff in a second game segment in which players choose from several masked awards. The Office Action states that Yoseloff does not teach the following:

Means for disclosing information about the awards to the player including that one of the of the unmasked awards is an enticement award having a value greater than the value of the initial award.

The Office Action states that regardless of this deficiency this element would have been obvious to an artisan at the time of the invention. The Office Action reasons that "slot machines typically disclose information to players about potential awards to entice them to risk a present value for the chance of a larger payoff". The Office Action gives the example of Yoseloff displaying a payable listing the payout per coin wager by the player. The Office Action concludes that it would have been obvious to an artisan at the

time of the invention to modify the game system disclosed by Yoseloff, wherein players are enticed to wager their winnings for the opportunity to win a larger payoff, to provide means for informing players of the values of the potential payoffs to allow them to evaluate the wager's risk.

One embodiment of the present invention includes revealing the values of all of the masked awards without disclosing the association of the values with each of the masked awards. Thus, while the player may know all of the values of the masked awards, the player does not know which value is associated with a particular masked award. This is different than the payable disclosed in Yoseloff. The payable disclosed in Yoseloff provides general information of payouts relating to certain combination of symbols. The values included in Yoseloff's payable do not change with each game played, i.e., the payable's values are not altered for a new game or when a new phase of the game is played. One embodiment of the present invention includes values that are disclosed to the player and change with each game. The information or plurality of values disclosed in the present invention is game specific, and are not general values which may or may not be relevant for a particular game. In Yoseloff, the player's combination of symbols in a game may not contain symbols included in a number of the combinations of symbols displayed by the payable. Those combinations of symbols in the payable, which include symbols not being played by the player, are not relevant to the current game. In this embodiment of the present invention -- because the values change to suit each specific game -- there are no irrelevant values displayed to the player. This element of the present invention is accordingly not disclosed, taught or suggested by Yoseloff.

Yoseloff does not disclose, teach or suggest disclosing game specific values of all of the player's possible selections. Koza does not cure this deficiency of Yoseloff. Koza does not disclose, teach or suggest the values of the masked awards being disclosed to the player without disclosing the association of each of the values with each of the masked awards. The combination of Yoseloff and Koza does not disclose, teach or suggest the present invention. It is respectfully submitted that Claims 1 to 14,

and 38 are patentably distinguished over Yoseloff and Koza, and are in condition for allowance.

Claims 15 to 34 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Yoseloff in view of Koza, as applied to claims 1 to 14, in further view of Schwartz, et al., The Encyclopedia of TV Game Shows, 3rd Ed., Checkmark Books (1999)("the Encyclopedia").

Claims 15 to 33 have been amended to further clarify the present invention. Each embodiment of the present invention disclosed in these claims includes a gaming device with at least one movable mechanical member which masks the plurality of awards from the player and is controlled by a processor.

As explained above, Koza teaches away from Yoseloff. Koza discloses a game with awards provided to player independent of any player input, and Yoseloff discloses a game with awards being provided by player selections. The combination of Yoseloff, Koza and the Encyclopedia do not disclose, teach or suggest at least one movable mechanical member of a gaming device which masks the plurality of awards from the player. Yoseloff, Koza and the Encyclopedia do not disclose, teach or suggest the present invention. It is respectfully submitted that Claims 15 to 34 are patentably distinguished over Yoseloff, Koza and the Encyclopedia and are in condition for allowance.

The Office Action rejected Claims 35 to 37 under 35 U.S.C. § 103(a) as being unpatentable over Yoseloff in view of Koza and Encyclopedia, in further view of Fey (U.S. Patent No. 2,012,502). The Office Action states that the combination of Yoseloff with Koza and the Encyclopedia does not suggest the following features: (a) a secondary display device connected to a controller including means for revealing at least one of the masked awards; and (b) revealing means is a mechanical door that opens to disclose a masked award.

As explained above, Koza teaches away from Yoseloff. Koza discloses a game with awards provided to player independent of any player input, and Yoseloff discloses a game with awards being provided by player selections. The Office Action includes a fourth reference to argue that the present invention is obvious in light of these

references. It is respectfully submitted that the Office Action is utilizing improper hindsight with the use of different elements from these four different references. Like Koza, Fey does not teach a player selectable game but instead discloses a slot gaming machine. The Office Action is selectively culling elements out of these four references to argue that the present invention is obvious.

However, the combination of Yoseloff, Koza, the Encyclopedia and Fey does not disclose, teach or suggest the present invention. The present invention includes at least one movable mechanical member which masks the plurality of awards. The movable mechanical member reveals all of the plurality of awards after the player selects one of the awards. Fey discloses revealing only one prize when the player wins the game. Fey cannot reveal all of the prizes because the prizes in Fey are articles of merchandise held in compartments (Col. 2, l. 57 - Col. 3, l. 1). When the player wins the prize in Fey, one of the compartments is opened so that the player can collect the prize. If all of the compartments in Fey were opened to reveal the prizes to the player, the player could take or steal the prizes even though the player did not win all of the prizes. Fey does not cure the deficiency of Yoseloff, Koza and the Encyclopedia. Fey does not disclose, teach or suggest at least one movable mechanical member which reveals all of the plurality of masked awards to the player. It is respectfully submitted that the combination of Yoseloff, Koza, the Encyclopedia and Fey do not disclose, teach or suggest at least one movable mechanical member which masks the plurality of awards from the player. Claims 35 to 37 are patentably distinguished over Yoseloff, Koza, the Encyclopedia and Fey and are in condition for allowance.

An earnest endeavor has been made to place this application in condition for allowance and is courteously solicited. If the Examiner has any questions related to this Response, applicants respectfully request that the Examiner contact the applicants' attorney, Adam Masia, to discuss this Response.

Respectfully submitted,
BELL, BOYD & LLOYD LLC

BY



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Dated: August 12, 2003